

#12/Response
9.24.01

Patent C Wills

Attorney's Docket No. 007325-077

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Frank J. KOCH et al) Group Art Unit: 2857
Application No.: 09/542,640) Examiner: H. Vo
Filed: April 3, 2000)
For: COATING THICKNESS GAUGE)

FAX COPY RECEIVED
SEP 20 2001
TECHNOLOGY CENTER 280TRESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Official Action dated August 28, 2001, the Examiner is respectfully requested to reconsider the rejection set forth in the outstanding official action in view of the supplemental declaration submitted herewith.

The Examiner alleges that the reissue oath filed with the application is defective because it fails to identify at least one error which is relied upon to support the reissue application. In support of the rejection, the Examiner quotes from the Reissue Declaration. However, the Examiner failed to quote and appreciate an additional statement also contained in the original Declaration. In particular, the Examiners attention is directed to the 3rd full paragraph on page 2 of the Reissue Declaration. In that paragraph, the applicants state that they believe that U.S. Patent Number 5,930,744 may be at least partly inoperative for the reason that it claimed less than the inventors had a right to claim in the Patent. Specifically, the '744 patent did not include claims 31-45, which are included with the reissue application.

Application No. 09/542,640
Attorney's Docket No. 007325-077
Page 2

The case law and the Manual of Patent Examining Procedure have long held that an error, correctable by reissue, may be that the patent claimed more or less than the inventors had a right to claim in the Patent. See §1402 of the Manual of Patent Examining Procedure. Furthermore, the reissue Declaration specifically indicates that the error to be corrected by the reissue is the fact that the original patent claimed less than the inventors had a right to claim in the patent.

Although applicants believe that the original declaration meets the Patent Office requirements, in order to expedite prosecution, applicants submit herewith a supplemental declaration which includes more detail concerning the error. The supplemental declaration was discussed with Examiner Glick, who indicated that the proposed language was likely adequate.

The reissue application includes new claims 31-45, which define a scope of protection not included in the original patent. Such error is generally considered to be a defect resulting from conduct made in the preparation and/or prosecution of the Application which became the Patent, and is therefore correctable through reissue. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998) (the "error" requirement limits the availability of a reissue patent to certain correctable errors... [O]ne such correctable error is the patentee claiming his invention too broadly or too narrowly.")

Accordingly, applicants submit that the supplemental Declaration filed herewith clearly identifies at least one error which is relied upon to support the Reissue Application.

Application No. 09/542,640
Attorney's Docket No. 007325-077
Page 3

Accordingly, the Examiner is respectfully requested to withdraw the rejection and
to pass the Application to issue.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: William C. Rowland
William C. Rowland
Registration No. 30,888

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: September 20, 2001

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being
facsimile transmitted to the U.S. Patent and Trademark Office
Fax. No. (703) 308-7382 on September 20, 2001.

By: William C. Rowland
William C. Rowland
Registration No. 30,888

Date: September 20, 2001